

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 23-26 and 36-43 are pending in this application. Claims 1-22 and 27-35 have been canceled without prejudice or disclaimer. Claims 23, 36, and 40 have been amended to emphasize the manner of calculating the amount of overlap based upon a partial image picked up by a first pickup member and an image picked up by a second pickup member, with the overlapping amount calculated being the amount of overlap between the partial image picked up by the first pickup member and the image picked up by the second pickup member. Claims 42 and 43 have also been amended to correct typographical errors. All changes find clear support in the previously submitted claims and the elected embodiment so that there has been no introduction of new matter.

Moreover, it is respectfully submitted that the above noted amendments to the claims reduce the number of claims, do not raise any question of new matter being introduced, and do not raise any other new examination or search issues. Accordingly, amendment entry is believed to be clearly in order.

The outstanding Office Action presents an objection to Claim 42 and a rejection of Claims 23, 25, 26, 36-38, and 40-42 under 35 U.S.C. §103(a) as being unpatentable over Dunton et al. (U.S. Pat. No. 6,304,284, Dunton) taken in view of the "Official Notice" noted by the Examiner.

Initially, Applicants acknowledge with appreciation the indication that Claims 24, 39 and 43 are allowed.

Turning to the objection to Claim 42, it is noted that the present amendment corrects the dependency of this claim so it depends on method Claim 40 instead of apparatus Claim

36. Accordingly, it is respectfully submitted that this objection has been overcome and should be withdrawn.

The rejection of Claims 23, 25, 26, 36-38, and 40-42 under 35 U.S.C. §103(a) as being unpatentable over Dunton in view of Official Notice is traversed as to amended Claim 23 because Dunton has no reasonable teaching or suggestion of the Claim 23 image recording determination unit that will “determine whether or not a current partial image is to be recorded based upon the amount of overlap calculated by the overlapping amount calculating unit,” where this overlapping amount calculating unit is recited “to calculate an amount of overlap based upon the partial image picked up by said first image pickup unit and the image picked up by said second image pickup unit, wherein the overlapping amount is the amount of overlap between the partial image picked up by said first image pickup unit and the image picked up by said second image pickup unit.” Also missing is the required control unit in the image recording unit that will respond “to the determination that a current partial image is to be recorded to automatically perform the recording.”

The outstanding Action points to FIG. 5 blocks 504 and 524 as well as col. 7, lines 56-57, col. 8, lines 48-51, and col. 4, lines 63-67 to teach subject matter corresponding to such limitations. However, col. 7, lines 56-57, simply state that a picture is taken from a first position relative to block 504, not that anything other than the operator takes the picture or that it is taken after a calculation of overlap between images individually obtained from different image pickups is performed. It is only after this picture is taken that any computation is said to occur (at col. 7, lines 58-59) relative to block 508.

While the field of view of the single pickup is suggested to then help determine the number of degrees to move this single pickup to take the next image with a proper amount of overlap (at col. 7, line 62-col. 8, line 5), this is not a teaching of obtaining two different images from two different sources and making a calculation of overlap between these two

different images. Just as there is no teaching of the required calculation of an overlapping amount at col. 7, lines 56-57, with the calculated amount being “the amount of overlap between the partial image picked up by said first image pickup unit and the image picked up by said second image pickup unit,” there is also none at col. 8, lines 25-32 that clearly bases prompts to a user for camera movement on only the information of the present image being observed through the single camera taught by Dunton. Moreover, the non-automatic prompting of the user to record the image is set forth at col. 8, lines 30-33 and is a clear departure from the claimed requirement for automatically performing the recording.

Further in this last regard, the paragraph bridging columns 7 and 8 of Dunton simply teaches that images are recorded at different positions, not how to do this “automatically.” To the extent that the PTO is suggesting that the artisan, if properly motivated, could design and implement an automatic recording arrangement, it is well established that such within the skill of the artisan arguments are insufficient to establish a *prima facie* case of obviousness. *See In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) noting that simply because a prior art device “may be capable of being modified to run the way the apparatus is claimed” this alone does not establish obviousness because “there must be a suggestion or motivation in the reference to do so.”

Similarly, simply because Col. 5, lines 2-6 and col. 8, lines 25-32 suggest that there must be a sufficient or proper amount of overlap between images, these suggestions do not teach calculating an amount of overlap using two different images from even one image source, much less the claimed use of two different images from two different image sources.

With regard to the suggested use of focal length and field of view of but one lens to assist in calculating overlap regions suggested at col. 3, lines 45-47, it is again noted that this broad suggestion appears related to the suggested use of field of view to calculate degrees of camera rotation noted at col. 7, line 63-col. 8, line 6 that are discussed above. In any event,

the broad suggestion that some type of overlap calculation is to be made cannot be reasonably said to teach the calculation required by the rejected claims.

Furthermore, while col. 6, lines 43-45 may describe what is common to an overlap region in terms of corresponding points from different images being in the overlap region where two images are combined and col. 6, line 66-col. 7, line 2 may teach camera movements (rotation, translation) used too achieve an overlap region that is “properly aligned between two images,” neither of these disclosures teach the above noted overlap calculations. In addition, the consideration of the “summary” of col. 7, lines 35-43, overlap is achieved by the control and monitoring of the camera position based on movement to predetermined positions determined to provide proper overlap as suggested at col. 7, lines 60-65, for example. Once again, the outstanding Action simply presumes that the artisan could use the claimed calculations without evidence that points to establishing the motivation required by the *Mills* decision discussed above.

Page 4, lines 12-15, of the outstanding Action appear to confuse the separate argument that Dunton does not teach or suggest making an overlap calculation based upon the images picked up by two different pickups, i.e. the actual images actually being picked up, and the separate argument that Dunton does not teach or suggest responding to a determination that a current partial image is to be recorded to “automatically perform recording.

Furthermore, and contrary to the assertion in the paragraph bridging pages 4 and 5 of the outstanding Action, there is no teaching of responding to a determination that a current partial image is to be recorded to “automatically perform recording” that appears in FIG. 5 as to indicators 504 and 524; at col. 7, lines 56-57; at col. 8, lines 48-51, or at col. 4 lines 63-67. For example, while col. 4 lines 63-67, indicate that a picture is recorded when the camera is at a second position, there is no teaching or suggestion here that this recording is done

“automatically.” The same lack of any disclosure of an “automatic” recording is true as to FIG. 5 indicators 504 and 524; col. 7, lines 56-57; and col. 8, lines 48-51. The PTO simply assumes the word “automatic” to be present as to various teachings that a camera makes a recording, but no such teaching that these recordings are made “automatically” is presented. Assumptions and speculation are not evidence and cannot be substituted for such required evidence. *See In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967) (“The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.”) To the extent that the PTO is further expressing the view that the artisan could design and implement a control arrangement to make these suggested recordings “automatically,” the above-noted *Mills* decision clearly requires the establishment of proper motivation to do this.

Furthermore, col. 8, lines 42-47, require manual adjustments of camera positions that have nothing to do with the claim required determining of the “amount of overlap calculated by the overlapping amount calculating unit” or the automatic recording of a picture.

Furthermore, “Official Notice,” is not evidence placed in the record. It is widely held to be inappropriate to rely on Official Notice for the crux of a rejection instead of as a replacement for evidence of minor auxiliary matters. Here, Official Notice is improperly relied on to first create separate cameras dedicated to performing different multiple functions and then to add such camera to Dunton without properly establishing motivation to not only complicate the single camera of Dunton, but also to do it in a manner that requires this second camera to pickup an image and to use it to make the claimed calculation of the amount of overlap that is not taught by Dunton.

Fist, it is noted that the only function that applies to all cameras is that of recording a picture. As there are no different picture recording functions present or alleged, the simple

question, unanswered in the rejection, is why the artisan would have been led to use two cameras when only one will do as clearly taught by Dunton.

From this unanswered question and undocumented conclusion lacking any evidence in the record, the outstanding Action jumps to a second conclusion that using a plurality of individual cameras is a “simplified design” some how easier to repair and trouble shoot as stated at page 7, lines 5-10. These undocumented conclusions that are being offered in place of the evidence required by the PTO reviewing Court is a clear violation of that precedent. In this last regard, the court in *In re Zurko*, 59 USPQ2d 1693, 1697-98 (Fed. Cir. 2001) noted the following:

We cannot accept these findings by the Board. This assessment of basic knowledge and common sense was not based on any evidence in the record and, therefore, lacks substantial evidence support. As an administrative tribunal, the Board clearly has expertise in the subject matter over which it exercises jurisdiction. This expertise may provide sufficient support for conclusions as to peripheral issues. With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience — or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.

An even more recent decision, *In re Lee*, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002) has emphasized the need for both examiners and the Board to provide evidence, not mere unsupported opinion, as follows:

In finding relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from this viewpoint [that of the person of ordinary skill in the art to which the subject matter pertains]. Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record.

This prohibition as to using “Official Notice” in place of actual evidence in something other than a very minor “fill in the gaps” capacity was further emphasized as being improper in *In re Ahlert*, 165 USPQ 418, 421 (CCPA 1970):

Typically, it is found necessary to take notice of facts which may be used to supplement or clarify the teachings of a reference disclosure, perhaps to justify or explain a particular inference to be drawn from the reference teaching. The facts so noted serve to 'fill in the gaps' which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection. We know of no case in which facts judicially noted comprised the principle evidence upon which a rejection was based were of such importance as to constitute a new ground of rejection when combined with the other evidence previously used. [Emphasis added.]

Accordingly, it is again submitted to be clear that the outstanding Office Action improperly attempts to use "Official Notice" as a substitute for the required production of evidence as to a core factual finding.

Rather than explain why "Official Notice" can be properly used as a substitute for making a required showing based upon actual evidence of this core fact needed to establish obviousness, the outstanding Action attempts to once again avoid the case law and the limitations it places on the use of "Official Notice" fully acknowledged in the Summary of MPEP § 2144.03 as follows:

Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421 [emphasis added].

To whatever extent that MPEP § 2144.03 requires a different traversal of the logical basis presented for properly taking "Official Notice," it can only be applicable when these prerequisites have been met in terms of the "Official Notice" being used to insubstantially fill in gaps, not as the core evidence being relied upon as Official Notice is prohibited as a substitute for actual core evidence as noted above.

In addition, in addressing the subject matter from Claim 25 at the bottom of page 7 of the outstanding action, the PTO acknowledges that Dunton does not teach this subject matter. The outstanding Action then attempts to modify the actual teaching at col. 8, lines 42-51, of Dunton, as to manual camera adjustments, as somehow suggesting the claimed stopping of “acquiring the partial images when an amount of shift of said first image pickup unit is greater than a desired value.” However, teaching at col. 8, lines 42-51, concerns positioning the camera to acquire a recording, it in no way suggests or reasonably teaches the required stopping of “acquiring the partial images when an amount of shift of said first image pickup unit is greater than a desired value.”


Independent Claims 36 and 40 clearly parallel independent Claim 23 and also have been amended to emphasize the manner of calculating overlap using each image from a different image source. Thus, independent Claims 23, 36, and 40 are all believed to clearly patentably define over Dunton with or without the improperly invoked “Official Notice.” As Claims 26, 38, 41, and 42 all depend from one of these base independent claims, they are also believed to patentably define over Dunton and the improperly invoked “Official Notice” for the same reasons as their respective parent claims.

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Reply to Office Action of 12/15/2005

As no other issues are believed to remain outstanding relative to this application, it is believed to be clear that this application is in condition for formal allowance and an early and favorable action to this effect is, therefore, respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Gregory J. Maier', is written over a horizontal line.

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